RECEIVED CENTRAL FAX CENTE

ARNOLD & PORTER LLP

202,942,5000 202.942.5999 Fax AUG 2 0 2004

555 Twelfth Street, NW Washington, DC 20004-1206

Fax Transmittal

August 20, 2004

RECIPIENT NAME(S)	RECIPIENT FAX NUMBER(S)		RECIPIENT TELEPHONE NUMBER(S)
US Patent and Trademark Office Board of Patent Appeals and Interferences	(703) 872-9306 (703) 308-6200		(703) 305-4673
SENDER	SEN	DER'S TELEPHONE NUMBER	SENDER'S ROOM NUMBER
Thomas E. Holsten	(202) 942-5085		981
CLIENT/MATTER NUMBER	TIMEKEEPER NUMBER		NUMBER OF PAGE(S)
16517.001	5230		We are transmitting 32 page(s) (including this cover sheet)
TRANSMISSION DEADLINE (DATE &	TIME)	ALTERNATE TELEI	PHONE NUMBER (OPTIONAL)
This document must be transmitted no later than: August 20, 2004/ASAP		Alternate telephone number at which the sender can be reached if there are difficulties with this fax: (202) 942-5159	
If you experience difficulty receiving the	nis fax trai	l nsmission, please contact ti	he operator at 202.942.5837.

Re: Appeal Nos. 2003-1072, 2003-1073, 2003-1074, 2003-1666, 2003-1939, 2004-1034, 2004-1272,

2004-1273, 2004-1275, 2004-1406, 2004-1480, 2004-1725, 2004-1773 and Application No. 09/267,199 (BHAT et al.) filed March 12, 1999 (Conf. No. 6701)

Atty. Dkt. Nos.: 16517.323, 16517.326, 16517.324, 16517.128, 16517.277,

16517.314, 16517.032, 16517.285, 16517.276, 16517.272,

16517.281, 16517.231, 16517.142 and 16517.233

See the attached. Please acknowledge receipt via return facsimile.

PRIVILEGED AND CONFIDENTIAL

Information intended only for the use of the addressee named above. If the reader of this message is not the intended recipient or the employee or agent responsible for delivering the message to the intended recipient, please note that any dissemination, distribution or copyling of this communication is strictly prohibited. Anyone who receives this communication in error should notify us immediately by telephone and return the original message to us at the above address via the U.S. Mall.

ARNOLD & PORTER LLP

Thomas E. Holsten Thomas_Holsten@aporter.com

202,942,5085 202,942,5999 Fax

555 Twelfth Street, NW Washington, DC 20004-1206

August 20, 2004

VIA FACSIMILE

Board of Patent Appeals and Interferences United States Patent and Trademark Office P.O. Box 1450 Alexandria, Virglnia 22313-1450

Re: Requests for Suspension of Appeal

Dear Sir:

Transmitted herewith for appropriate action by the U.S. Patent and Trademark Office is a Request for Suspension of Appeal for each of the following applications:

 Appeal No.: Not Yet Assigned/Conf. No. 6701 Serial No. 09/267,199, filed March 12, 1999

Applicants: Barkur G. BHAT et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with the Tocopherol

Pathway

Attorney Docket No.: 16517.233

Appeal No.: 2003-1072

Serial No. 09/333,534, filed June 14, 1999 Applicants: Timothy W. CONNER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.323

3. Appeal No.: 2003-1073

Serial No. 09/540,234, filed April 3, 2000 Applicants: Timothy W. CONNER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.326

4. Appeal No.: 2003-1074

Serial No. 09/552,086, filed April 19, 2000 Applicants: Robert E. BUEHLER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.324

5. Appeal No.: 2003-1666

Serial No. 09/521,640, filed March 10, 2000

Applicants: Joseph R. BYRUM et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.128

ARNOLD & PORTER LLP

Board of Patent Appeals and Interferences U.S. Patent and Trademark Office August 20, 2004 Page 2

Appeal No.: 2003-1939

Serial No. 09/333,535, filed June 14, 1999

Applicants: Joseph R. BYRUM et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.277

7. Appeal No.: 2004-1034

Scrial No. 09/666,355, filed September 20, 2000

Applicants: Karen L. FINCHER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.314

Appeal No.: 2004-1272

Serial No. 09/371,146, filed August 9, 1999

Applicants: Nordine CHEIKH et al. Title: Annotated Plant Genes Attorney Docket No.: 16517-032

Appeal No.: 2004-1273

Serial No. 09/637,086, filed August 11, 2000

Applicants: Karen L. FINCHER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.285

10. Appeal No.: 2004-1275

Serial No. 09/540,235, filed April 3, 2000

Applicants: Dane K. FISHER et al.

Title: Nucleic Acid Sequences from Cyanidium Caldarium and Uses Thereof

Attorney Docket No.: 16517.276

11. Appeal No.: 2004-1406

Serial No. 09/553,094, filed April 18, 2000

Applicants: Scott E. ANDERSEN et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.272

ARNOLD & PORTER LLP

Board of Patent Appeals and Interferences U.S. Patent and Trademark Office August 20, 2004 Page 3

12. Appeal No. 2004-1480

Serial No. 09/732,627, filed December 8, 2000

Applicants: Karen L. FINCHER et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.281

13. Appeal No.: 2004-1725

Serial No. 09/233,218, filed January 20, 1999

Applicants: Claire A. CAJACOB et al.

Title: Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole

Pathway

Attorney Docket No.: 16517.231

14. Appeal No.: 2004-1773

Serial No. 09/421,106, filed October 15, 1999

Applicants: Joseph R. BYRUM

Title: Nucleic Acid Molecules and Other Molecules Associated with Plants

Attorney Docket No.: 16517.142

It is respectfully requested that acknowledgement of receipt of these waivers be sent via return facsimile to the undersigned at 202-942-5999.

In the event that extensions of time are necessary to prevent abandonment of these patent applications, then such extensions of time are hereby petitioned. Appellants do not believe any fees are due in conjunction with these filings. However, if any fees are required in the present applications, including any fees for extensions of time, then the Commissioner is hereby authorized to charge such fees to Arnold & Porter LLP Deposit Account No. 50-2387, referencing docket number 16517.001.

V David R. Marsh (Reg. No. 41,408)

Thomas E. Holsten (Reg. No. 46,098)

Enclosures

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

AUG 2 0 2004

In re application of:

Art Unit:

1637

Claire A. CAJACOB et al.

Examiner:

Young J. Kim

Appln, No.: 09/233,218

Atty. Dkt. No.: 16517.231

Filed:

January 20, 1999

Appeal No.:

2004-1725

Title:

Nucleic Acid Molecules and Other Molecules Associated with the Tetrapyrrole

Pathway

Request for Suspension of Appeal

Commissioner for Patents P.O. Box 1450 Alexandria, VA 22313-1450

Sir:

Appellant hereby requests that the Board of Patent Appeals and Interferences ("Board") suspend action in the above-captioned appeal. The issues presented in the appeal involve the utility of partial nucleic acid molecules, such as Expressed Sequence Tags (ESTs), under 35 U.S.C. §§ 101 and 112 and the sufficiency of the written description of these sequences. An appeal involving the utility of partial nucleic acid molecules is currently pending before the United States Court of Appeals for the Federal Circuit ("Federal Circuit"). The sufficiency of the written description has been decided by the Board under similar circumstances as the present appeal. 1

On April 28, 2003 Appellant filed a Notice of Appeal in the above-captioned matter. Thereafter, Appellant filed an Appeal Brief with the Patent Office on June 27, 2003 and waived oral hearing on July 22, 2004.

On May 27, 2004, the Real Party in Interest in the above-captioned matter filed an appeal to the Federal Circuit in In re Fisher (U.S. Appln No. 09/619,643, B.P.A.I. Appeal

I hereby certify that the foregoing Request for Suspension of Appeal is being facsimile transmitted to the attention of the Board of Patent Appeals and Interferences, via facsimile number (703) 308-6200, and to the U.S. Patent and Trademark Office central facsipale number (703) 872-9306.

PAGE 29/32 * RCVD AT 8/20/2004 4:49:35 PM [Eastern Daylight Time] * SVR:USPTO-EFXRF-1/2 * DNIS:8729306 * CSID:202 942 5209 * DURATION (mm-ss):08-56. August 20, 2004

Rejections for the lack of sufficiency of the written description, have repeatedly been reversed by the Board in similar cases. See, Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.

Claire A. CAJACOB et al. Ser. No. 09/233,218 Appeal No. 2004-1725 Page 2

No. 2002-2046) presenting the issue of the utility of partial nucleic acid molecules, such as ESTs under 35 U.S.C. §§ 101 and 112. ²

The Office has stated that postponing consideration of an appeal until the Board has the benefit of a Federal Circuit decision, which may be determinative of an issue in the appeal, is sound practice. See e.g., M.P.E.P. §1213, 8th Edition, Revision No. 2, at page 1200-31.

For these reasons, Appellant hereby requests that the Board suspend consideration of the present appeal until the Federal Circuit provides guidance on the issue of the utility of partial nucleic acid molecules, such as ESTs. Should the Commissioner require additional information, he is invited to contact the undersigned at the number provided below.

Respectfully submitted,

Date: August 20, 2004

Thomas E. Holsten (Reg. No. 46,098) David R. Marsh (Reg. No. 41,408)

Of Counsel Lawrence M. Lavin, Jr. (Reg. No. 30,768) Thomas E. Kelley (Reg. No. 29,938) Monsanto Company ARNOLD & PORTER LLP 555 Twelfth Street, NW Washington, DC 20004-2402 (202) 942-5000 telephone (202) 942-5999 facsimile

² The Board has upheld Examiners' utility rejections in similar appeals. See, e.g. Appeal Nos. 2003-1137, 2003-0996, 2003-1504, 2003-1746 and 2002-2046.